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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,094	07/10/2001	Michael A. Goldstein	P 0283000	7433
909	7590	05/19/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	
DATE MAILED: 05/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/901,094	GOLDSTEIN, MICHAEL A.	
	Examiner Marissa Thein	Art Unit 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 31 January 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-42 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-42 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 10 July 2001 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

The "Reply to Restriction Requirement" filed on January 31, 2005 was persuasive, thus, Examiner will withdraw the restriction requirement.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 20-21 and 23-42 have been renumbered as claims 19-20 and 22-41. Examiner will use the Applicant's original numbers with the new renumbering of claims in parenthesis in the rejection. For claim 21 which Applicant has used twice, Examiner will identify as claim 21a and claim 21b. Applicant did not identify a claim 19.

### ***Claim Rejections - 35 USC § 101***

#### **35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. The claimed invention must utilize technology in a non-trivial manner. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. There is no structural or functional interrelationship with these method steps. Therefore, the claim is nothing more than an abstract idea, which is not tied to any technological art and is not a useful art. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD, Pats. App. & Inter. 2001). See MPEP 2106 IV 2(b). To overcome this rejection the Examiner recommends that Applicant amend the claims, for example, claim 1 can be rewritten as, "A computerized method for providing ....."; and "outputting at least one interest category for view by user via computer....", etc.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-42 (1-41) are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,421,652 to Loeb.**

Regarding claims 1 and 23 (22), Loeb discloses a method and system for providing a user with samples of products during a sample-subscription period (free subscription of magazines), comprising: an interface (col. 6, lines 36-37); outputting at least one interest category for review by a user (provides universal questionnaire to consumers, col. 3, lines 60-62); a processor (col. 6, lines 34-41); receiving information from the user indicating a selection of at least one interest category (stores information received from consumers in consumer database, col. 3, lines 63-65); requesting delivery of products corresponding to the selected at least one interest category to the user during the sample-subscription period (free-subscription) (based on the answers received from the consumer.....determines that trade publication consumer is entitled to, notifies consumer of such and also transmit data to fulfillment house, requesting fulfillment house to prepare the appropriate subscription for each consumer, col. 3, line 65 – col. 4, line 3).

Regarding claims 2-6, 8-13, 15-18, 26-27 (25-26), 29-34 (28-33), 36-39 (35-38), and 42 (41), Loeb discloses outputting a query to the user requesting the user to subscribe to one of the products delivered during the sample-subscription period (col. 4, lines 40-43; col. 10, lines 12-24); the products are delivered from a product manufacturer to the user (col. 3, lines 43-46; col. 4, lines 30-34); wherein an order is based on availability of at least one of the products to be delivered to the user (col. 7,

line 65- col. 8, line 12); an order is based on information provided by the user (col. 9, lines 47-50; col. 12, lines 25-27), product availability (col. 7, line 65- col. 8, line 12) and at least one product manufacturer's request (col. 11, lines 20-41; col. 10, lines 2-4; col. 11, lines 59-62); an order is based on at least one product manufacturer's request (col. 11, lines 20-41; col. 10, lines 2-4; col. 11, lines 59-62); and an order is based on a request of the user (col. 10, lines 16-18).

Regarding claims 7 and 28 (27), Loeb discloses the receiving information from the user indicating the selection of at least one interest category receives information indicating selection of two or more interest categories and requesting delivery of products requests delivery of at least two different products to the user during the sample-subscription period based on the selected interest categories (col. 9, lines 47-50; col. 9, lines 1-2; col. 9, lines 66-67; col. 12, lines 34-36).

Regarding claims 24-25 (23-24), Loeb discloses a memory storing a user profile (col. 5, lines 27-34; col. 6, lines 34-41); a web page (web page, col. 4, lines 21-22).

Regarding claims 14 and 35 (34), Loeb discloses a method and system for providing a user with samples of products during a sample-subscription period (free subscription of magazines), comprising: an interface (col. 6, lines 36-37); outputting at least one interest category for review by a user (provides universal questionnaire to consumers, col. 3, lines 60-62); a processor (col. 6, lines 34-41); receiving information from the user indicating a selection of at least one interest category (stores information received from consumers in consumer database, col. 3, lines 63-65); formulating a customized, personal interest category based on the selected at least two interests

selected by the user (col. 12, lines 15-38; Figure 11a-11c; col. 13, lines 3-28); requesting delivery of products corresponding to the selected at least one interest category to the user during the sample-subscription period (free-subscription) (based on the answers received from the consumer....determines that trade publication consumer is entitled to, notifies consumer of such and also transmit data to fulfillment house, requesting fulfillment house to prepare the appropriate subscription for each consumer, col. 3, line 65 – col. 4, line 3).

Regarding claims 20 (19), 21a (20), 21b (21), and 40-41 (39-40), Loeb discloses determining at least one interest corresponding to at least one product (col. 13, lines 5-10; Figure 11a); formulating an outputting a proposed order in which products are delivered to the user during the sample-subscription period based on the determined at least one interest (Figure 11a; Figure 8); the proposed order may be altered by a request from the user (col. 9, lines 66-67); and wherein an order is based confirmation provided by the user frequency of publications, and publishers' request (col. 8, line 66 – col. 9, line 9; col. 14, lines 34-45).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,014,641 to Loeb et al. discloses a system for providing an open-ended subscription to commodity items normally available only through term-based subscription.

U.S. Patent No. 6,334,113 to Walker et al. discloses a system and method for selling subscription to periodicals in a retail environment.

U.S. Patent No. 6,535,857 to Clarke III et al. discloses a method for distributing early issues of a periodical subscription to a consumer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on 571-272-6788. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mtot  
May 13, 2005

*Michael Cuff* 5/13/05  
MICHAEL CUFF  
PRIMARY EXAMINER